

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**Status of the Claims**

Claims 1-52, 61 and 68 are canceled, and claims 53-59 were previously withdrawn. Claims 60, 62, 67, 69, 70, 73, 74, 76, and 77 have been amended herein. No new matter has been added. Upon entry of these amendment, claims 53-60, 62-67 and 69-77 remain pending in the present application.

**Objection to the Specification**

The abstract of the disclosure is objected to because “the form and legal phraseology often used in patent claims, such as ‘means’ and ‘said,’ should be avoided.” In response, Applicants have amended the abstract to resolve the issue raised in the Office Action, and Applicants submit that the objection has been overcome. Accordingly Applicants respectfully request that the objection to the abstract be withdrawn.

**Rejections under 35 U.S.C. § 102 and § 103(a)**

Claims 60, 73 and 74 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Papineni et al. (U.S. Patent No. 6,246,981) (hereinafter Papineni). Claims 60-64, 66-70 and 72-75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable by Gabai et al. (U.S. Patent No. 6,773,344) (hereinafter Gabai) in view of Papineni. Claims 65 and 71 stand rejected under 35 U.S.C. § 103(a) as being unpatentable by Gabai in view of Papineni and further in view of Uwakubo (U.S. Patent No. 6,513,011) (hereinafter Uwakubo). Claims 76 and 77 stand rejected under 35 U.S.C. § 103(a) as being unpatentable by Papineni in view of McAllister et al. (U.S. Patent No. 6,385,584) (hereinafter McAllister). The rejections are traversed as follows.

In response, without agreeing or acquiescing to the rejections, Applicants have cancelled claims 61 and 68 and amended independent claims 60, 67, 73, 74, 76, 77 and dependent claims 62, 69, 70. As amended, all the independent claims 60, 67, 73-77 clarify

that the additional information is added before the beginning of or after the end of translated text. This feature, in combination with the other features of the claims, is not disclosed, taught, or suggested by the cited prior art, alone or in combination.

Specifically, amended claim 60 recites, in part, “adding the additional information to the translated text with a change processing device so that the additional information is added before the beginning of the translated text or after the end of the translated text; and outputting the translated text to which the information is added with an information reproducing device.” The Office Action acknowledges that Papineni does not disclose these features of claim 61. *See* Office Action, at 17. Therefore, Papineni does not disclose each and every element of claim 60, as amended. Although of different scope, amended claims 73 and 74 recite similar features. Applicants submit that Papineni does not disclose each and every element of at least claims 60, 73, and 74. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 102 be withdrawn.

The Office Action relies on the combination of elements found in Gabai and Papineni to reject claims 60-64, 66-70 and 72-75 under 35 U.S.C. § 103(a). Applicant respectfully submit that the Office Action does not satisfy the factual finding requirements under *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and does not establish a prima facie showing of obviousness.

First, Gabai and Papineni are not analogous art. The MPEP provides that “[t]he examiner must determine what is ‘analogous prior art’ for the purpose of analyzing the obviousness of the subject matter at issue.” § 2141.01 (a). Analogous art must be “either (1) in the field of applicant’s endeavor or (2) be reasonable pertinent to the particular problem with which the applicant was concerned.” M.P.E.P. § 2141 (II)(A).

The present application is directed to an information processing system. *See, e.g.*, Abstract. Gabai is directed to “methods and apparatus for integrating interactive toys with interactive television and cellular communication systems.” *Gabai*, Abstract. Papineni is directed to a system of conversant interaction. *Papineni*, Abstract. Therefore, Gabai and Papineni are not in the same field of endeavor of the present application.

Furthermore, Gabai and Papineni are not reasonable pertinent to the particular problem with which the present application was concerned. The object of the present application is to provide an information process system “which can reproduce not only the result of information processing, but also information other than the result.” *Present Application*, [0017]. In contrast, Gabai aims at allowing “toy owners who do not have available a personal or other computers to operate interactive toys.” *Gabai*, Column 3, Lines 32-39. Papineni tries to provide a “dialog manager which is more versatile in interacting a user,” which “can respond[] to information on a wide range of topics in natural language and is easily adaptable to new tasks,” and which can “interact[] with a single user on a plurality of topics.” *Papineni*, Column 2, Lines 66-67; Column 3, Lines 1-5. Thus, Gabai and Papineni are not reasonable pertinent to the particular problem with which the present application was concerned. Therefore, Gabai and Papineni are not analogous art.

Secondly, even assuming Gabai and Papineni are analogous art, the Office Action does not provide a proper rationale that supports a conclusion of obvious. In particular, the Office Action does not provide any proper teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to combine Gabai and Papineni to arrive at the present application.

In the rejection of claim 60, the Office Action states that “[i]t would have been obvious to someone of ordinary skill in the art at the time of the invention to apply the confirmations/clarifications of Papineni with the base process of dialog interaction in Gabai because the result would have been predictable in providing a machine/user dialog interaction where the machine and user have a mutual understanding of the current dialog state.” *Office Action*, at 17. However, as discussed previously, Gabai is directed to interactive toys that can integrate with interactive television and cellular communication systems. There is no teaching, suggestion, or motivation in either Gabai or Papineni to suggest that combining interactive toys with a conversant interaction system would lead to present application’s information processing system.

The MPEP provides that when establishing a prima facie case of obviousness, “the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s)

why the claimed invention would have been obvious.” M.P.E.P. § 2142. The Office Action only provides a conclusory statement and thus does not provide clear articulation of the reason why present application would have been obvious.

Further, “[i]t is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the . . . art.” M.P.E.P. § 2141.01(III) (citations omitted). Here, it is impermissible hindsight to combine features in Gabai with features in Papineni when no proper rationales to support a conclusion of obvious is made in the Office Action.

Finally, in any event, even though Applicants believe that Gabai and Papineni are not analogous art and are not properly combinable, Applicants submit that the amended claims clearly distinguish out Gabai and Papineni.

Papineni teaches a conversation system (for example, *see* Column 14, Lines 55 to 57). In Papineni, “[m]essage construction by the dialog manager 40 involves interpolating variables, evaluating some standard functions provided by the dialog manager, and finally producing a piece of text to be passed to the target of the message.” Column 9, Lines 12-16. For example, Papineni teaches that the computer responds “confirming purchase of one hundred Shares of vanguard index trust total stock market institutional shares. Please say yes or no (fund name from context)” to “I want to buy one hundred shares” of the human. Column 15, Lines 25-29. Therefore, Papineni does not disclose that the additional information is added before the beginning of the translated text or after the end of the translated text; rather, it merely teaches inserting text in a predefined script.

Gabai teaches that a toy acts as translator of a spoken language. However, Gabai does not teach that the translated text is analyzed and the additional information selected by the analysis is added to the translated text.

Because Gabai and Papineni, either alone or in combination, do not disclose or suggest each and every element in claims 60, 67, 73, 74, or 75, Applicants respectfully request that the rejection be withdrawn and that independent claims 60, 67, 73, 74, and 75 be

allowed. Further, because claims 62-64 depend from claim 60, claim 66 depends from claim 62, and claims 69, 70, and 72 depend from claim 67, claims 62-64, 66, 69, 70, and 72 should be allowed for at least the reasons set forth above without regard to further patentable features contained therein.

Claim 65 depends from claim 62 which depends from independent claim 60. Claim 71 depends from independent claim 67. As discussed above, Gabai and Papineni, either alone or in combination, do not disclose or suggest each and every element in claim 60 and 67. More specifically, Gabai and Papineni, either alone or in combination, do not disclose that the additional information is added before the beginning of the translated text or after the end of the translated text. Applicants submit that Uwakubo also fails to disclose or suggest such features. Accordingly, Applicants respectfully request that the rejection be withdrawn and claims 65 and 71 be allowed.

Claims 76 and 77, as amended, recites in part, that “additional information is added before the beginning of the translated text or after the end of the translated text.” As discussed above, Papineni does not disclose such features. Applicants submit that McAllister also fails to disclose or suggest such features. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Additionally, Applicants respectfully submit that the Office Action fails to provide a clear articulation of the reasons why claims 76 and 77 would have been obvious. In particular, the Office Action does not provide some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to combine Papineni and McAllister to arrive at the present application.

The Office Action states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the confirmation responses (as taught by Papineni, yes or no confirmations, column 15) with the random wording variation (as taught by McAllister) so that ‘random wording variations are included in the prompts as would be characteristic of a human operator.’ (McAllister, Column 2, lines 28-39)”.

However, if “the confirmation responses” in Papineni is combined with “the random wording variation” in McAllister, as suggested by the Office Action, the conversation system in Papineni will be rendered unsatisfactory for its intended purpose. As indicated in Papineni, “Conversational systems are generally task-oriented. This means that their role is to help users achieve a specific goal in a particular application domain.” Column 1, Lines 12-14. The invention in Papineni employs a dialog manager which “having task-oriented forms for associating user input information therewith, the dialog manager being capable of selecting an applicable form from the task-oriented forms responsive to the input information by scoring the forms relative to each other.” Abstract.

Thus, if randomness is introduced into such a conversation system of task-oriented forms, the output (*e.g.*, Computer’s response to human’s input) will be unpredictable, rendering the system unsatisfactory for its intended purpose. As indicated in MPEP, “if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. § 2143.01(V). Accordingly, Applicants respectfully request that the rejection be withdrawn and claims 76 and 77 be allowed.

### **CONCLUSION**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under

37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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